

### REMARKS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 1-18 are currently pending. Claims 1-18 have been amended by the present amendment. The changes to the claims are supported by the originally filed specification and do not add new matter.

In the outstanding Office Action, Claims 1-18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,317,848 to Sorens et al. (hereinafter “the ‘848 patent”) in view of U.S. Patent 5,956,698 to Lacheze et al. (hereinafter “the ‘698 patent”).

Amended Claim 1 is directed to a method of monitoring usage of a monitored image output device, comprising: (1) receiving an electronic mail message transmitted using an Internet protocol, the electronic mail message comprising information related to usage of the monitored image output device; (2) automatically extracting identifying information of the monitored image output device from the electronic mail message; (3) automatically extracting total page count information of the monitored image output device from the electronic mail message, the total page count information indicating the total number of pages printed by the monitored image output device; and (4) automatically storing the total page count information in association with the identifying information in a database.

Applicants respectfully submit that the rejection of Claim 1 (and dependent Claims 2-5 and 16-18) is rendered moot by the present amendment to Claim 1.

Regarding the rejection of Claim 1 under 35 U.S.C. § 103(a), the Office Action asserts that the ‘848 patent discloses that everything in Claim 1 with the exception of automatically extracting page count information and automatically storing the page count information, and relies on the ‘698 patent to remedy those deficiencies.

The '848 patent is directed to a method for tracking and communicating printer failures and usage profile information. The '848 patent discloses that, upon occurrence of a triggering event, a report is sent from the printer in a predetermined format. As shown in columns 3 and 4 of the '848 patent, the report format includes a header and a body. The body of the report includes various information fields including "prints-since-last-jam" information. However, Applicants respectfully submit that the '848 patent fails to disclose extracting total page count information of the monitored image output device from an electronic mail message, wherein the total page count information indicates the total number of pages printed by the monitored image output device, as recited in amended Claim 1. Accordingly, it follows that the '848 patent cannot disclose receiving an electronic mail message having the page count information or storing the total page count information extracted from the electronic mail message, as recited in amended Claim 1.

The '698 patent is directed to a printing system in which the billing for a print job by a user is accounted for using an accounting log manager. As shown in Figures 3-5, the '698 patent discloses a system in which a "billable event supplier" sends a "description" of a billable event to an accounting log manager, which may then record the billable event. In this regard, the '698 patent discloses that the descriptions "are provided by, among other sources, various subsystems of the resource layer 16, which resources may be distributed across local and/or wide area networks."<sup>1</sup> Thus, Applicants respectfully submit that the '698 patent fails to disclose receiving and automatically extracting information from an electronic mail message, as recited in Claim 1. Further, Applicants respectfully submit that the '698 patent fails to disclose automatically extracting total page count information of a monitored image output device from the electronic mail message, the total page count information indicating the total number of pages printed by the monitored image output device, as recited in

---

<sup>1</sup> '698 patent, column 8, lines 58-61.

amended Claim 1. Rather, the '698 patent is directed to the reporting and accounting of a billable event, e.g., a printing job by a particular user, and the "descriptions" disclosed by the '698 patent do not include total page count information that indicates the total number of pages printed by a monitored image output device, as recited in amended Claim 1.

Thus, no matter how the teachings of the '848 and '698 patents are combined, the combination does not teach or suggest the extracting step recited in amended Claim 1. Accordingly, Applicants respectfully submit that amended Claim 1 (and dependent Claims 2-5 and 16-18) patentably defines over any proper combination of the '698 and '848 patents.

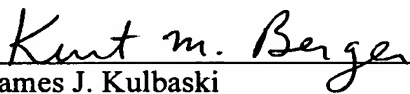
Independent Claims 6 and 11 recite limitations analogous to the limitations recited in amended Claim 1. Moreover, Claims 6 and 11 have been amended in a manner analogous to the amendment to Claim 1. Accordingly, for the reasons stated above, for the patentability of Claim 1, Applicants respectfully submit that the rejections of Claims 6 and 11 (and all associated dependent claims) are rendered moot by the present amendment to Claims 6 and 11.

Thus, it is respectfully submitted that independent Claims 1, 6, and 11 (and all associated dependent claims) patentably define over any proper combination of the '848 and '698 patents.

Consequently, in view of the present amendment and in light of the above discussion, the outstanding grounds for rejection are believed to have been overcome. The application as amended herewith is believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.

  
\_\_\_\_\_

James J. Kulbaski  
Attorney of Record  
Registration No. 34,648  
Kurt M. Berger, Ph.D.  
Registration No. 51,461

Customer Number

**22850**

Tel: (703) 413-3000  
Fax: (703) 413 -2220  
(OSMMN 06/04)

JJK:KMB\law

I:\ATTY\KMB\249's\249134US-MOTOYAMA\249134US-AF.DOC